

REMARKS

Applicants respectfully submit that the amendments add no new matter and are fully supported by the application as originally filed.

Rejections under 35 U.S.C. §102(e) and under 35 U.S.C. §103(a)

The Examiner has rejected Claims 1-6, 11-14 under 35 U.S.C. §102(e) as being anticipated by Colbert et al. (U.S. Patent 6,824,755). The Examiner has rejected Claims 1-13 under 35 U.S.C. §102(e) as being anticipated by Morita et al. (U.S. Patent 6,221,489). The Examiner has rejected Claim 14 under 35 U.S.C. 103(a) as being unpatentable over Morita, and further in view of Colbert.

Applicants have amended independent Claim 1 to recite a nanotube having a controllably shaped contour and a varying cross-sectional dimension along the longitudinal axis, wherein the nanotube comprises a material selected from the group consisting of boron nitride, boron carbide, carbon nitride, boron carbon nitride and transition metal chalcogenides.

Neither Colbert nor Morita taught nanotubes comprising boron nitride, boron carbide, carbon nitride, boron carbon nitride or transition metal chalcogenides. Applicants submit that amended Claim 1 is patentably distinct from the teachings of both Colbert and Morita.

Independent Claim 14 recites a catalyst comprising the nanotube of (currently amended) Claim 1, i.e., a nanotube having a controllably shaped contour and a varying cross-sectional dimension along the longitudinal axis, wherein the nanotube comprises a material selected from the group consisting of boron nitride, boron carbide, carbon nitride, boron carbon nitride and transition metal chalcogenides.

Colbert taught single-wall carbon nanotube catalyst supports. He did not teach catalysts comprising boron nitride, boron carbide, carbon nitride, boron carbon nitride or transition metal chalcogenides, as recited in Claim 14. Applicants submit that Claim 14 is patentably distinct from the teachings of Colbert.

Claims 2 and 3 have been cancelled.

Dependent Claims 4-13 each depend from independent Claim 1 and therefore include all the features and limitations thereof. Furthermore, the dependent claims add further distinguishing features of particular utility. Accordingly, Applicants submit that the dependent claims are also allowable over both Colbert and Morita.

Appl. No: 10/717,144
Amdt. dated: January 16, 2008
Reply to Office Action of: October 17, 2007

CONCLUSIONS

In view of the foregoing amendments and remarks, Applicants submit that the application is in condition for allowance. If, however, some issue remains which the Examiner feels may be addressed by Examiner's amendment, the Examiner is cordially invited to call the undersigned for authorization.

Please charge any additional fees, including fees for additional extensions of time, or credit overpayment to Deposit Account No. 120690.

Respectfully submitted,
Regents of the University of California
Customer No. 08076

Date: January 16, 2008

By: /R'Sue Popowich Caron/

R'Sue Popowich Caron
Registration No. 52,699
Agent of Record
Lawrence Berkeley National Laboratory
One Cyclotron Road MS: 90B0104
Berkeley, CA 94720
(510) 486-6503 rpcaron@lbl.gov